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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/599,000	09/18/2006	Kouji Hatano	NGB-41245	3056
53054 7590 10/14/2010 PEARNE & GORDON LLP 1801 EAST 9TH STREET SUITE 1200 CLEVELAND, OH 44114-3108				
EXAMINER WANG-HURST, KATHY W				
ART UNIT PAPER NUMBER 2617				
NOTIFICATION DATE DELIVERY MODE 10/14/2010 ELECTRONIC				

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/599,000

Applicant(s)

HATANO, KOUJI

Examiner

KATHY WANG-HURST

Art Unit

2617

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 August 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 7-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 7-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI.08)
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date: _____

DETAILED ACTION

Response to Amendment

1. Applicant's amendment filed on 8/18/2010 has been entered. Claims 1-2, 5 and 9-12 are amended. New claims 15-16 are added. Claims 1-5, 7-16 are pending for examination.

Response to Arguments

1. Applicant's arguments filed 8/18/2010 have been fully considered but they are not persuasive.

Regarding the applicant's argument that the prior art of record does not teach that a change of the superposition of the output of the reproducing unit and the output of the informing unit in time series is made based on the contents being reproduced (see pages 7-8), the examiner respectfully disagrees. Tagawa discusses fading in of the ring tone and fading out of the media reproduction when a call is received during the reproduction of the media (see [0055][0127][0128][0129]). Tagawa specifically discusses a time sequence where the reproduction of music is fading out while the ring tone is fading in, thus superposing each other (see Figs. 14A and 14B). Therefore Tagawa teaches a change of the superposition of the output of the reproducing unit and the output of the informing unit in time series is made. Tagawa discusses the ring tone is selected based on certain condition, e.g. the identification of the caller but does not specifically discuss the ring tone is selected based on the contents being reproduced. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to set other conditions on which the selection of a ring tone is

based. In an analogous art, Futamase teaches a tone generating means for generating a tone signal based on the performance information of the media being played ([0008]). Therefore the combination of Tagawa and Futamase teaches a change of the superposition of the output of the reproducing unit and the output of the informing unit in time series is made based on the contents being reproduced.

Regarding the applicant's argument that Futamase's ring tone is generated first and the music is executed based on the ring tone (see pages 8-9), the examiner respectfully disagrees. Firstly, Futamase discusses a tone generating means for generating a tone signal corresponding to the performance information ([0008]). Specifically Futamase discusses the CPU sends performance events to the tone generator on the basis of the performance data to sound a corresponding tone ([0231]). Therefore it is clear the music is played first and ring tone is generated afterwards. Secondly, it is common sense that a user is enjoying the media and is subsequently interrupted by an incoming call and a ring tone is generated to inform the user of the incoming call. Therefore it only makes logical sense that the ringing tone is generated *after* the media is already being played.

Concerning the combination of references, both of the references are from the same field, i.e. communication systems and concern analogous topics. Therefore, the examiner contends that the references would be combinable to one skilled in the art.

Therefore, the argued limitations read upon the cited references or are written broad such that they read upon the cited references, as follow.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-5 and 7-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tagawa et al (US 2002/0045438) in view of Futamase et al. (2004/0007120).

Regarding claim 1, Tagawa discloses an information terminal, comprising:

- a reproducing unit that reproduces contents ([0020], [0062], [0065], where Tagawa discusses playing music files, therefore a reproducing unit);
 - an informing unit that informs an occurrence of an event ([0020], [0068], ring tone output unit to inform incoming calls);
 - a superposing unit that superposes an output of the reproducing unit and an output of the informing unit ([0020] outputting a ring tone while the reproduction unit is reproducing playing music, therefore superimposing the outputs); and
 - a controlling unit that controls an informing of the occurrence of the event and a superposition of the output of the reproducing unit and the output of the informing unit in an optimum reproducing procedure selected from a plurality of reproducing procedures ([0020] and [0026] a control unit controlling events and executing [0023] different reproduction modes previously set) so that the superposition is changed gradually ([0112]),
- wherein a change of the superposition of the output of the reproducing unit and the output of the informing unit in time series is made (see at least [0055][0127]

[0128][0129] where Tagawa discusses fading in of the ring tone and fading out of the media reproduction being controlled by the reproducing procedures in a time sequence; [0023] selecting a ringing tone is based on certain condition such as the communicating party, therefore there must be a list/metadata of contact information such that the calling party is detected and recognized based on the list/metadata).

Tagawa also discloses the controlling of the informing of occurring event and a superposition of the reproducing unit and informing unit is performed based on the identification of a communicating party ([0023]-[0025]), however, Tagawa does not specifically disclose the controlling of the informing of occurring event and a superposition of the reproducing unit and informing unit is performed based on meta information extracted from the contents being reproduced.

In an analogous art, Futamase teaches the controlling of the informing of occurring event and a superposition of the reproducing unit and informing unit is performed based on meta information extracted from the contents being reproduced (see [0230][0231], where Futamase discusses the ring tone is selected based on performance data of the music data being played; and also see Fig. 16, where Futamase shows performance data is extracted from the music information, therefore meta data extracted from contents being reproduced is used to generate the corresponding ring tone).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the invention of Tagawa, have reproducing procedure is selected based on media contents being played, as taught by Futamase,

thus allowing a better way of handling an interrupt by selecting a ringing tone based on the music being played (see [0008][0230][0231]).

Regarding claim 5, Tagawa discloses a method of informing an event that occurs during reproduction of contents,

controlling a superposition of an output of a reproducing unit and a output of an informing unit and an informing of an occurrence of an event in an optimum reproducing procedure selected from a plurality of reproducing procedures ([0020] and [0026] a control unit controlling events and executing [0023] different reproduction modes previously set) so that the superposition is changed gradually ([0112]),

wherein a change of the superposition of the output of the reproducing unit and the output of the informing unit in time series is made (see at least [0055][0127] [0128][0129] where Tagawa discusses fading in of the ring tone and fading out of the media reproduction being controlled by the reproducing procedures in a time sequence; [0023] selecting a ringing tone is based on the communicating party, therefore there must be a list/metadata of contact information such that the calling party is detected and recognized based on the list/metadata).

Tagawa also discloses the controlling of the informing of occurring event and a superposition of the reproducing unit and informing unit is performed based on certain condition such as identification of the communicating party ([0023]-[0025]), however, Tagawa does not specifically disclose the controlling of the informing of occurring event and a superposition of the reproducing unit and informing unit is performed based on the contents being reproduced.

In an analogous art, Futamase teaches the controlling of the informing of occurring event and a superposition of the reproducing unit and informing unit is performed based on meta information extracted from the contents being reproduced (see [0230][0231], where Futamase discusses the ring tone is selected based on performance data of the music data being played; and also see Fig. 16, where Futamase shows performance data is extracted from the music information, therefore meta data extracted from contents being reproduced is used to generate the corresponding ring tone).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the invention of Tagawa, have reproducing procedure is selected based on media contents being played, as taught by Futamase, thus allowing a better way of handling an interrupt by selecting a ringing tone based on the music being played (see [0230][0231]).

Regarding to claim 2, Tagawa discloses the information terminal according to claim 1, further comprising: a storing unit that stores the plurality of the reproducing procedures ([0074] lines 3-5, a memory that stores reproduction methods); and an extracting unit that extracts the meta information to select the reproducing procedure from the contents, wherein the controlling unit causes the superposition of the output of the reproducing unit and the output of the informing unit and the information of the occurrence of the event to execute in the reproducing procedure selected based on the extracted meta information ([0068]).

Regarding claim 3, Tagawa discloses the information terminal according to claim 1, further comprising: a storing unit that stores the plurality of the reproducing procedures ([0074] lines 3-5, a memory that stores reproduction methods); and an acquiring unit ([0150] acquire data) that acquires data that is corresponded to the contents. ([0068] it is inherent that there exists an acquiring unit to acquire data so that the control unit can execute).

Regarding claim 4, Tagawa discloses the information terminal according to claim 1, further comprising: a storing unit that stores the plurality of the reproducing procedures; and a sensing unit that senses a state of the terminal ([0068] can sense/detect the state of the terminal, i.e. terminal is reproducing music when a call arrives), wherein the reproducing procedure is selected based on the sensed state of the terminal ([0068]).

Regarding claim 7, Tagawa discloses the method of informing the event according to claim 5, wherein the reproducing procedure is selected based on information that is corresponded to the contents ([0075]).

Regarding claim 8, Tagawa discloses the method of informing the event according to claim 5, wherein the reproducing procedure is selected based on a state of a terminal ([0067] - [0069]).

Regarding Claims 9-12, combination of Tagawa and Futamase teaches the optimum reproducing procedure is selected based on the information of contents being reproduced (see e.g. Futamase: [0008][0116][0124][0136][0231] ring tone is selected based on the performance data of the media being played).

Regarding claim 13-14, combination of Tagawa and Futamase teaches the superposition changing is performed based on type of the contents being reproduced (see Futamase: [0230][0231] and Fig. 16).

3. Claims 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tagawa in view of Futamase and further in view of Hameleers et al. (US2007/0198650) which is filed on Nov. 11, 2003 in English.

4. Claims 15 and 16, the combination of Tagawa and Futamase discloses cross fading the video output of the reproducing unit and the sound output of the informing unit (see Tagawa: [0055][0127][0128][0129]), and the outputs of the reproducing unit includes a video output and a sound output (Futamase: [0005][0010]), but does not specifically disclose the informing unit includes a video output and a sound output. However it is well known in the art the informing unit has multimedia output.

In an analogous art, Hameleers discloses the informing unit includes a video output and a sound output (Abstract and [0005] where Hameleers discusses calling party is identified by a video sequence, audio stream, etc.).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the invention of Tagawa and Futamase, to incorporate multimedia feature of the informing unit, as taught by Hameleers, thus allowing a better way of presenting the identification of the calling party ([0005][0021]).

Conclusion

2. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KATHY WANG-HURST whose telephone number is (571) 270-5371. The examiner can normally be reached on Monday-Thursday, 7:30am-5pm, alternate Fridays, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nick Corsaro can be reached on (571) 272-7876. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/KATHY WANG-HURST/
Examiner, Art Unit 2617

/HUY PHAN/
Primary Examiner, Art Unit 2617